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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,086	09/26/2000	Yuji Sawada	55168(55)	4078

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/647,086

Applicant(s)

SAWADA ET AL.

Examiner

Matthew s Gart

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-- Th MAILING DATE of this communication appears on the cov r sheet with the correspond nc addr ss --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 29-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5.11.12</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 29-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 29-30, comprise a copy permission determining means for reading copy permission information and for determining whether copying of said digital data is permitted or not.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Claims 29-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-19 have been withdrawn from further consideration in view of Applicants' response to the Examiner's Restriction Requirement in Paper No. 9.

Claims 20, 22, 23, and 24 have been amended via Paper No. 13. New claims 27-30 have been added via Paper No. 13. Claims 1-30 are pending in the instant application.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the number of the amendments renders it difficult to consider the application, and to arrange the papers for printing or copying.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 20-28 are rejected under 35 U.S.C. 102(b) as being anticipated by  
Wilson U.S. Patent No. 5,195,092.**

Referring to claim 20. Wilson discloses a data reproducing apparatus reproducing digital data including reproducing apparatus specifying information specifying an apparatus capable of reproduction (abstract), comprising:

- A storage apparatus storing reproduction apparatus ID information unique to said reproducing apparatus;
- A first determining apparatus determining whether said reproduction apparatus is capable of reproducing said digital data from said reproduction apparatus ID information and said reproducing apparatus specifying information (at least column 7, lines 1-31); and
- A control apparatus enabling or disabling reproduction of digital data by said reproducing apparatus dependent on the result of determination by said first determining apparatus (at least Fig. 2 and claim 13).

Referring to claim 21. Wilson further discloses a data reproducing apparatus wherein:

- Said digital data includes display data reproduced visually (at least Fig. 2); and
- Said reproducing apparatus comprising a display apparatus for visually reproducing and displaying said digital data (at least Fig. 2).

Referring to claim 22. Wilson further discloses a data reproducing apparatus further comprising an ID information input apparatus responsive to determination by said first determining apparatus that said reproducing apparatus is not a reproducing apparatus capable of reproducing said digital data, urging a user to enter a reproducing apparatus ID information (at least column 2, lines 34-58).

Referring to claim 23. Wilson further discloses a data reproducing apparatus comprising:

- A second determining apparatus determining whether the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproducing apparatus capable of reproducing said digital data; wherein said control apparatus enables or disables reproduction of digital data by said reproducing apparatus dependent on the result of determination by said second determining apparatus (at least column 2, lines 34-58 and column 7, lines 1-31).

Referring to claim 24. Wilson further discloses a data reproducing apparatus comprising:

- An update selecting apparatus responsive to the determination by said second determining apparatus that the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproduction apparatus capable of reproducing said digital data, allowing the user to select whether said reproducing apparatus specifying information is to be updated by said input reproducing apparatus ID information (at least column 21, lines 5-42); and
- An updating apparatus responsive to the selection by said update selecting apparatus that said reproducing apparatus specifying information is to be updated by said reproducing apparatus specifying information by said input reproducing apparatus ID information (at least column 21, lines 5-42).

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Referring to claims 25-26. Claims 25-26 are rejected under the same rationale as set forth above in claims 20-24.

Referring to claim 27. Wilson further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when reproduction is first performed by the data reproducing apparatus (at least column 36, line 26 to column 38, line 20).

Referring to claim 28. Wilson further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when the digital data is sold (at least column 36, line 26 to column 38, line 20).

### ***Response to Arguments***

Applicant's arguments filed March 18, 2004 have been fully considered but they are not persuasive.

The Attorney argues that Wilson does not disclose a data reproducing apparatus wherein the data to be reproduced is to be individually selected by the user at the time of use of the apparatus, and that the reproduction of that data is to be limited to a uniquely designated reproduction apparatus (Attorney's Remarks: Page 30, Paper No. 13).

The Examiner notes, the Attorney amended claim 20 to recite the limitation of an uniquely designated reproduction apparatus.

The Examiner further notes, Wilson does disclose an invention that manipulates, processes and transmits all data destined for a particular subscriber in digital format. At

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the CATV headend, the data is transmitted to a plurality of field devices which are locally distributed throughout the area serviced by the system. These field devices, known as "presentation players", each have their own identification ("ID") number, and can identify and intercept the digital data addressed to them. When a subscriber requests a particular presentation, the interactive system ensures that the particular digital data required to construct that presentation is transmitted to the subscribers' local presentation player (column 7, lines 1-31).

The Examiner further notes, the presentation player **54** monitors all the CATV distribution frequencies that are being transmitted and locks in on the particular distribution frequency which is transmitting data for the digital interactive multimedia presentation and communications system. Each presentation player has a unique identification code in the form of a digital address. The presentation player **54** selects for further processing only that data which is addressed to them. Each presentation player **54** then converts the data that is destined to a particular subscriber along its line, produces a finished presentation, and transmits the finished presentation on the correct display channel frequency which the subscriber is viewing.

The Attorney notes, he/she has not been able to find anything in Wilson's Claim 13 that appears to anticipate the control apparatus of the instant inventions Claim 20 (Attorney's Remarks: Page 32, Paper No. 13).

The Examiner notes, the control apparatus in the instant invention enables or disables the reproduction of digital data by said reproducing apparatus. This is equivalent to the distribution system of Wilson's claim 13, wherein the distribution



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system has a means for preferentially distributing stream data from selected ones of said stream data sources onto a single distribution channel.

The Attorney argues that Wilson does not disclose the data reproducing apparatus of the present invention which includes storage apparatus that stores unique identification information in order to uniquely identify it (Attorney's Remarks: Page 33, Paper No. 13).

The Examiner reiterates, Wilson does disclose an invention that manipulates, processes and transmits all data destined for a particular subscriber in digital format. At the CATV headend, the data is transmitted to a plurality of field devices which are locally distributed throughout the area serviced by the system. These field devices, known as "presentation players", each have their own identification ("ID") number, and can identify and intercept the digital data addressed to them. When a subscriber requests a particular presentation, the interactive system ensures that the particular digital data required to construct that presentation is transmitted to the subscribers' local presentation player (column 7, lines 1-31).

### ***Examiner's Comments***

Attached is the acknowledgement of the following Information Disclosure Statements received by the Office:

IDS: Paper No. 5                      2/8/2001

IDS: Paper No. 11                  12/22/2003

IDS: Paper No. 12

3/11/2004

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

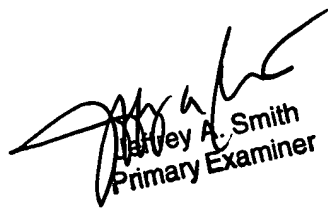
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746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

March 29, 2004



Jeffrey A. Smith  
Primary Examiner